

### **REMARKS**

Claims 1, 3, 7 and 35 have been amended, claims 2, 21, 22 have been canceled, claims 8-20 and 25-31 have previously been canceled, and new claims 36-40 have been added. Thus, claims 1, 3-7, 23, 24, and 32-40 are currently pending and presented for examination. Applicants respectfully request reconsideration and allowance of the pending claims in view of the foregoing amendments and the following remarks.

#### Response to Claim Objections:

Applicant has amended claim 3 as suggested by the Examiner and therefore respectfully request the Examiner to withdraw the objection.

#### Response to Rejections Under Section 112:

Applicant has amended claim 1 to provide proper antecedent basis and therefore respectfully request the Examiner to withdraw the Section 112 rejection.

#### Response to Rejections Under Section 103:

Claims 1-4, 6-7, and 23-25, 32 and 33 stand rejected under 35 U.S.C 103(a) as being obvious over McDowell et al. (USPgPub 2002/0035605) in view of Sztetzo (USPgPub 2004/0215731). Claim 5 stands rejected under 35 U.S.C 103(a) as being obvious over McDowell in view of Sztetzo and in further view of IETF;2.1.12 SIP for Instant Messaging and Presence Leveraging (simple); 7/31/01. Claims 34-35 stand rejected under 35 U.S.C 103(a) as being obvious over McDowell in view of Sztetzo and in further view of Enete et al (USPgPub 2003/0208543). Applicant respectfully submits that these claims are patentable and respectfully request the Examiner to withdraw the Section 103 rejection.

Claim 1

In response to Applicant's RCE on August 28, 2008, for Applicant's limitation *registering the software application by a monitoring application as a first communication partner in a list of communication partners accessible in the network, the software application residing on a first computing machine* the Examiner states "in order to communicate with IM users, an IM user must install the IM program and register an account and buddy list with the IM server; therefore, the IM user's IM program is a software application and the monitoring application is the IM server". Thus, the Examiner apparently equates McDowell's IM program as Applicant's software application. Applicant respectfully submits that the interpretation of an IM program as Applicant's software application is inconsistent with the specification as well as how it would be interpreted by one of ordinary skill in the art.

During patent examination, the pending claims must be "given their broadest reasonable interpretation consistent with the specification." (MPEP 2111)

The Patent and Trademark Office ("PTO") determines the scope of claims in patent applications not solely on the basis of the claim language, but upon giving claims their broadest reasonable construction "in light of the specification as it would be interpreted by one of ordinary skill in the art." *In re Am. Acad. of Sci. Tech. Ctr.*, 367 F.3d 1359, 1364[, 70 USPQ2d 1827] (Fed. Cir. 2004).

Consistent with the specification and as well as how it would be interpreted by one of ordinary skill in the art, Applicant's application is clearly not the IM program but a program separate from IM. For Example, the application Winword.Exe may be monitored (for example, see page 9 lines 16-18). Winword.Exe pertains to Microsoft's Word application and not an IM program.

The Examiner further states that "Szeto discloses *transmitting information identifying a software application to be monitored to the first computing machine, the information including the name of the software application ([0082]-[0084])*". As Applicant has previously submitted, Szeto is a continuation-in-part with a filing date of July 2, 2003 and that Applicants have claimed priority to the German application 10257454.5 having a filing date of December 9, 2002. Priority was claimed by the Preliminary Amendment which was filed along with the certified priority document, both of which were submitted on December 01, 2003. The Examiner responded to

Applicant's argument in the Advisory Action mailed August 15, 2008 stating "Claims 9-11 of the '900 Patent (Column 12) clearly shows the subject matter claimed in that words may be read from instant messages and used to perform functions (i.e., control commands). Applicant disagrees for at least the following reasons.

- First, Applicant's limitation is *transmitting information identifying a software application to be monitored to the first computing machine, the information including the name of the software application* and not the limitation "words may be read from instant messages and used to perform functions (i.e., control commands)" as stated by the Examiner.
- Second, the Szeto's parent application (US 7,133,900) does not teach or suggest *transmitting information identifying a software application to be monitored to the first computing machine, the information including the name of the software application*.
- Third, Szeto's parent application (US 7,133,900) does include the information provided by [0082]-[0084] in Szeto (2004/0215731). Paragraphs [0082]-[0084] are not found in Szeto's parent application and the paragraphs pertain to FIG 11 which not present in the parent application.
- Fourth, Szeto (2004/0215731) [0082]-[0084] teach transmitting an application and data as an IM message and transmitting communication messages between users as user messages and does not teach or suggest *transmitting information...including a name of the software application*.

In view of the above, it is respectfully submitted that independent claim 1 is patentable. Furthermore, claims 4-7, 23, 24, 32-36, which depend on claim 1, are also patentable at least based on their dependency as well as their own merits.

### Claim 23

The Examiner indicates that Szeto (2004/0215731) [0084] teaches Applicant's limitation *of entering, by a user of the second communication partner, the information identifying the software application prior to the transmitting*. Thus, since the information include[es] a name of

the software application (claim 1), a user enters the information identifying the software application including the name of the software application.

As Applicant has argued in respect to claim 1, Szeto (7,133,900) does not teach this limitation. Thus, the Examiner must use the filing date of July 2, 2003 for Szeto (2004/0215731) which is after Applicant's priority date. Furthermore, Szeto (2004/0215731) [0084] recites:

[0084] FIG. 12A is a flow chart illustrating the control and execution of IM applications in an instant messaging system, in accordance with one embodiment of the present invention. In step 1202, IM client 202 (FIG. 2 or 10) evaluates an IM message. From the IM message, the IM client 202 determines the application type (i.e., movie trailer, game, animated cartoon, advertisement, Flash presentation, etc.) in step 1204. Using an identifier, the IM application is retrieved in step 1206. In step 1208, a decision is made as to whether a supporting application is required such as a media player (Real Player, Windows Media Player), content viewer (Adobe Illustrator, Reader, etc.), or other media-based display application. If required, the supporting application is launched in step 1210. If a supporting application is not required or if the supporting application has been launched, then the IM application is implemented/executed in step 1212. Alternative embodiments pertinent to the type of IM application implemented are shown in FIGS. 12B through 12D.

Applicant respectfully submits that Szeto [0084] does not teach or suggest entering the information identifying the software application prior to the transmitting, let alone that the entering, [is] by a user or that the entering is the name of software. In view of the above, it is respectfully submitted that dependent claim 23 is patentable.

#### Claim 35

Applicant has amended claim 35 to replace the term "host name address" with term "host name" which is the term known by those skilled in the art as well as term used in the specification (for example, see page 9 lines 32-35).

The Examiner indicates that Enete (2003/0208543) [0067] teaches Applicant's limitation *the software application identifying information includes a host name of a computing machine in which the software application is installed*. Enete [0067] recites:

[0067] The host 604 receives the instant message from the sender 602a (step 614) and then authenticates the instant message (step 616). In one implementation, the instant message includes header

information identifying the message type, the screen name and/or IP address of the sender 602a and the recipient 602b, and a randomly generated security number. A server (e.g., IM server 5902) on the host 604 may authenticate the instant message by matching the screen names and/or IP addresses with those of valid subscribers stored in a reverse look-up table. In the event that either the sender 602a or recipient 602b is not associated with a valid subscriber, the host 604 reports an error message.

Applicants respectfully submit that the pertinence of this reference is not apparent and consequently Applicants can only guess at the Examiner's view. Applicants are unsure to what the Examiner equates as Applicants' hostname but for the purpose of this response assume that it is either the host or screen name.

The pertinence of each reference, if not apparent, must be clearly explained and each rejected claim specified (MPEP706)

Applicant submits that host name is well known by those skilled in the art and that a host name is the unique name in which a network-attached device is known on the network. The format of the hostname conforms to standards defined by the internet engineering task force (IETF). A conversion between the hostname and device address such as IP address is handled by a Domain Name System (DNS) (for example, see page 9 lines 32-35.

The specification need not disclose what is well-known to those skilled in the art and preferably omits that which is well-known to those skilled and already available to the public. *MPEP 2164.05(a)*

Applicants respectfully submit that Enete's host 604 is the instant message provider that allows clients, sender 602a and receiver 602b, to communicate with each other (Enete [0016], Abstract). A host which provides instant messaging could not reasonably be considered by one skilled in art as a host name. Furthermore, Applicant's host name [is] of a computing machine in which the software application is installed. Since the Examiner has previously equated the IM user's IM program as the software application, the host name would therefore need to be of the IM user's IM program. However, Enete's clients are the IM user's and not the host.

Applicant respectfully submits a screen name is pseudonym for the IM user and cannot reasonably be considered as a host name. Furthermore, a user is not tied to a device; therefore, a screen name is not device specific whereas the host name is. Moreover, the interpretation of a

screen name as a host name is inconsistent with the specification as well as how it would be interpreted by one of ordinary skill in the art.

During patent examination, the pending claims must be “given their broadest reasonable interpretation consistent with the specification.” (MPEP 2111)

The Patent and Trademark Office (“PTO”) determines the scope of claims in patent applications not solely on the basis of the claim language, but upon giving claims their broadest reasonable construction “in light of the specification as it would be interpreted by one of ordinary skill in the art.” *In re Am. Acad. of Sci. Tech. Ctr.*, 367 F.3d 1359, 1364[, 70 USPQ2d 1827] (Fed. Cir. 2004).

New Claims:

New claims further define the scope of the invention as described in the specification and drawings. In view of the foregoing remarks regarding the other claims, Applicants respectfully submit claims 36-40 are patentable and requests allowance of claims 36-40.

Claims 36 and 40

Claim 40 further recites the limitation the state information is displayed by the second computing machine as part of a buddy list Support for this limitation may be found, for example, at page 10 line 36 page 11 line 12.

Claim 37

Claim 37 recites the limitations of claim 1 and further includes the limitation of canceled claim 2. At least for the reasons discussed above for claim 1, Independent claim 37 is patentable. Furthermore, claims 38-40 which depend on claim 37, are patentable at least based on their dependency as well as based on their own merits.

Claim 38

Claim 38 recites the limitation of canceled claim 21.

Claim 39

Claim 39 recites the limitation of canceled claim 22.

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### Conclusion

The commissioner is hereby authorized to charge any appropriate fees due in connection with this paper, including fees for additional claims and terminal disclaimer fee, or credit any overpayments to Deposit Account No. 19-2179.

Respectfully submitted,

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